

## **REMARKS**

### **I. Introduction**

Upon entry of the present amendment, claims 1-76 will be pending in this application. Claims 1, 13, 23 and 67 have been amended in the present response to clarify the features of the invention. No new matter has been added.

Because the present amendments (1) do not raise new issues requiring further consideration or search, (2) do not introduce new matter, (3) materially reduce the issues for appeal, and (4) place this application into better condition for allowance, entry is appropriate under 37 C.F.R. § 1.116, and is respectfully requested.

Based on the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

### **II. Objections to the Claims**

The Examiner stated that the amendment filed April 21, 2004 fails to comply with 37 C.F.R. 1.173 in that there were inaccuracies as to added or deleted claim language. Applicants respectfully submit that the enclosed amendment corrects any errors in added or deleted claim language. Applicants respectfully request reconsideration thereof.

### **III. Rejections under 35 U.S.C. § 112**

The Examiner has rejected claims 1, 3-8, 10-13, 67-69, 71, 73 and 74 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner states that in claim 1, line 22, "the wall" is indefinite as to which of the wall is being referenced. A

similar error occurs in claim 13. In claim 67, lines 2-4, the Examiner questions how the flanges can extend from the cup when they are claimed as being part of the cup.

Applicants thank the Examiner for his careful reading of the claims. Applicants respectfully submit that the amendments to claims 1, 13 and 67 overcome the objections and request withdrawal thereof.

#### **IV. Rejections based on 35 U.S.C. § 102**

The Examiner has rejected claim 23 under 35 U.S.C. § 102(b) as being anticipated by European Patent No. 0 663 193 to Hermann et al. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

The claims of the application are directed to an acetabular cup prosthesis that includes a cup body with a concave surface, a convex surface and an annular rim. The prosthesis includes a flanged portion extending away from the rim that helps attach the cup body to a patient's pelvis. The prosthesis also includes a buttress that helps secure a mass of cement in between the cup body and a polymeric liner.

To anticipate a claim, a reference must teach each and every element of the claim, either expressly or inherently. See M.P.E.P. § 2131. Applicants respectfully submit that *Hermann et al.* does not anticipate claim 23. *Hermann et al.* is directed to an artificial hip socket with "a holder and mounting system for implantation without bone cement." See *Hermann et al.*, title (emphasis supplied). The artificial hip socket shown in *Hermann et al.* includes a holder (4). The holder is a circular structure that is secured to the support (2) of

the hip socket by mountings (5). The holder holds an inner shell (3) against the support shell (2d).

Claim 23 requires, among other elements, a buttress that extends distally downwardly from the flange portion. The holder (4) of *Hermann et al.* is not a buttress. A buttress is used for support or reinforcement, as the buttress in the invention is used to support a mass of cement. *Hermann et al.* does not disclose that the holder (4) is capable of supporting a mass of cement or otherwise acting as a buttress. Furthermore, because *Hermann et al.* a system for implantation without bone cement, it is not inherent that the holder could act as a buttress. Moreover, the holder (4) does not extend distally downwardly as required by claim 23. Thus, claim 23 is not anticipated by *Hermann et al.*

#### **V. Rejections based on 35 U.S.C. § 103**

The Examiner has rejected claims 35, 36, 38, 41, 42, 47, 49, 51, 53, 56, 57, 59, 61, 63, 66 and 76 under 35 U.S.C. § 103(a) as being unpatentable over French Patent No. 2 660 546 to Balay et al. Applicants respectfully traverse these rejections and request reconsideration and withdrawal thereof.

The Examiner has rejected claims 24-34 under 35 U.S.C. § 103(a) as being unpatentable over by European Patent No. 0 663 193 to *Hermann et al.* Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or

to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See M.P.E.P. § 2142.

With respect to *Balay et al.*, the Examiner states that the cup member is seen as comprising the cup assembly 4 and the hemispherical insert 5. However, Applicants refer the Examiner to the attached translation of *Balay et al.*, which reveals that the hemispherical insert 5 is a polyethylene insert. See Exhibit A, page 4 and claim 3. The Examiner's proposed modification to *Balay et al.*, i.e., combining the cup assembly 4 and the hemispherical insert 5 to be a single member, would change the principle of operation of *Balay et al.* The operation of a hip implant generally requires a separate polyethylene insert to prevent wear between the acetabular cup and the femoral component. The proposed change would change the principle by which *Balay et al.* operates, therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious. See M.P.E.P. § 2143.01. The fact that these two parts are composed of different materials further underscores that the parts cannot in fact be combined to form one part. Furthermore, the buttress acts as support for the polyethylene cup. *Balay et al.* could not be modified such that the polyethylene cup acts as support for itself. Therefore, Applicants submit that a *prima facie* case of obviousness has not been made with respect to *Balay et al.*

As explained above, *Hermann et al.* is directed to an artificial hip socket with a holder and mounting system for implantation without bone cement. One with skill in the art would not be motivated to modify *Hermann et al.* to achieve the claimed invention, which presents

solutions for acetabular cup prostheses that use bone cement. Furthermore, *Hermann et al.* does not teach a buttress extending distally downwardly from the flange portion. Thus, even with the modifications suggested by the Examiner, *Hermann et al.* would not teach all of the claim limitations.

In summary, nothing in the references teaches or suggests an acetabular cup prosthesis that includes a cup body with a concave surface, a convex surface and an annular rim, flanged portions extending away from the rim that help attach the cup body to a patient's pelvis and a buttress that helps secure a mass of cement in between the cup body and a polymeric liner, as required in all claims. Applicants respectfully submit that the claims are not rendered obvious by either *Balay et al.* or *Hermann et al.*

## **VI. Allowable Claims**

The Examiner has indicated that claims 1, 3-8, 10-13, 67-69, 71, 73 and 74 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicants submit that the amendments to the claims overcome the rejections and request allowance of these claims.

The Examiner has indicated that claim 37 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants submit that based on the foregoing statements, claim 35, from which claim 37 depends, is in condition for allowance. Thus, Applicants request allowance of claim 37.

The Examiner has indicated that claims 14-22 are allowable over the prior art.

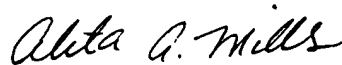
Applicants thank the Examiner for his consideration of these claims.

### CONCLUSION

In light of the amendments and the above remarks, Applicants are of the opinion that the Office Action has been completely responded to and that the application is now in condition for allowance. Such action is respectfully requested.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's Amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 815-6409 is respectfully solicited.

Respectfully submitted,



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